

## REMARKS

Claims 22-34 are pending in this application. Claims 22, 27, and 31 have been amended to clarify that player tracking information is displayed to the player without interfering with game play. Support for these amendments appears at page 10, lines 19-20. No new matter has been added.

### *Rejection under 35 U.S.C. §112*

Claims 22-34 are rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. While Applicant does not believe that the issue raised by the Examiner amounts to a failure to meet the enablement requirement, it appears that the perceived problem can be overcome by removing the term “enjoyment.” Therefore, to expedite prosecution, claims 22, 27, and 31 have been amended, removing the term “enjoyment,” and obviating the rejection. Withdrawal of the rejection is respectfully requested.

### *Rejection under 35 U.S.C. §103*

Claims 22-34 are rejected under 35 U.S.C. §103 as being unpatentable over US Pat. No. 5,971,271 to Wynn et al. (“Wynn”) in view of US Patent No. 6,241,524 to Aoshima et al. (“Aoshima”).

Applicants’ gaming machine as recited in claim 22 is patentable over the combination of Wynn and Aoshima at least because the combination of the references does not teach or suggest each and every one of the elements recited in claim 22.

The present invention is directed to a gaming machine in which the game video display is used to both present the game and loyalty bonus information, i.e., player tracking and loyalty award information (page 1, lines 10-13). Conventional gaming machines use additional displays (i.e., not the game video display) to present player tracking and loyalty award information (page 1, lines 27-29). Such an additional display is typically a small LCD (Liquid Crystal Display), LED (Light Emitting Diode display, or VFD (Vacuum Fluorescent Display) that does not have multi-color display capabilities (page 1, lines 27-29). By presenting player tracking information in combination with a game image on a single game video display, as claimed, this information is easier for the player to see (page 2, lines 15-16). As well, the information can be displayed in color with animated graphics, making the information even more noticeable (page 2, lines 16-18).

Wynn is directed to a teleconferencing gaming device. There is no teaching or suggestion of a video overlay device configured to overlay a player tracking information image

on the game image such that the image does not interfere with game play. The Examiner acknowledges as much at page 4, fourth paragraph of the most recent Office Action.

Aoshima is directed to a game apparatus that can display advice data appropriate to the state of the game such that the player can master the game while playing it. There is no teaching or suggestion of a video overlay device configured to overlay a player tracking information image on the game image such that the image does not interfere with game play.

In short, neither reference teaches or suggests a video overlay device configured to overlay a player tracking information image on the game image such that the image does not interfere with game play.

The Examiner asserts that Wynn teaches the claimed invention except for teaching “displaying information or an image (as in a player tracking image) that when overlaid on the screen does not interfere with the game image.” The Examiner uses Aoshima to provide this limitation. The Examiner asserts that “Aoshima teaches a message window 80 that is transparent such that it does not interfere with the game image.” The Examiner then concludes that “one of ordinary skill in the art would recognize that game images disrupting game play would irritate some players.” However, Aoshima does not teach a video overlay device configured to overlay a player tracking information image on the game image such that the image does not interfere with game play.

First, while the message window in Aoshima is transparent so as not to interfere with the *game image* (col. 10, lines 2-3), the message window necessarily interferes with *game play*. When the message window displays an advice message to help the player master the game (col. 1, lines 57-67), the player would need to take the time to read and process the advice message, which would interfere with game play. Furthermore, the message window in Aoshima is not displayed in a region of the game image that does not interfere with *game play*. Figures 8 and 9 show the message window displayed on the player’s tank 500 in Aoshima. Placing a message window on the player’s tank would interfere with game play because it would distract the player when the player is attempting to destroy other enemy tanks in the Aoshima video game (col. 5, lines 36-52).

Nothing in the Aoshima patent suggests an intent or purpose to avoid interfering with game play. In fact, much of the Aoshima patent suggests just the opposite. This is illustrated by the fact that in some of Aoshima’s embodiments, the game is placed in a pause state to display the advice message for a given time (col. 10, lines 50-51). The player may actuate a trigger to terminate the advice message (col. 10, lines 13-15). Both stopping the game in a pause state and having the player actuate a trigger to terminate the advice message also interfere with game play.

Regarding the video overlay device's ability to "determine one or more regions of the game image that are unimportant to game play" (claims 22 and 27), Aoshima clearly does not meet this limitation. The Examiner appears to be asserting, however, that Wynn teaches a device configured with this feature. The Examiner argues that Wynn:

teaches that if a player is in the middle of game play, the message will be postponed, or not sent at all, so as not to interfere with the game. If a player is in the middle of a game, then the entire game region is important and a message stream shall not be sent. Conversely, if a player is not in the middle of a game, then the entire game region is essentially unimportant, and a message may be sent.

This is not the same as determining "one or more regions of the game image that are unimportant to game play" (claim 22). In claim 22, the player tracking information and game image are simultaneously displayed on the same display even when a player is in the middle of a game. The video overlay device in claim 22 is far more sophisticated than the simple sending or not sending of the message described in Wynn in that the video overlay device determines "one or more regions of the game image that are unimportant to game play" (claim 22). Therefore, Wynn does not teach a video overlay device configured to "determine one or more regions of the game image that are unimportant to game play" (claim 22).

For at least the reasons given above, Applicants submit that claim 22 is patentable over the prior art. Claims 27 and 31 are patentable for the same or similar reasons. Withdrawal of the 35 U.S.C. §103 rejection for claims 22, 27, and 31 as well as for dependent claims 23-26, 28-30, and 32-34 is respectfully requested.

*Conclusion*

Applicants believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below. If any further fees are due in connection with the filing of this amendment, the Commissioner is authorized to charge such fees to Deposit Account 504480 (Order No. IGT1P311).

Respectfully submitted,  
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